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| 10/630,794 | 07/31/2003 | Satoshi Ogiwara | 00862.023166. | 7878 |
| 5514 7590 10/24/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | | |
| EXAMINER | | | | |
| MCLEAN, NEIL R | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/630,794

Applicant(s)

OGIWARA ET AL.

Examiner

Neil R. McLean

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 15-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 3 and 15-17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/29/2008 has been entered.

Status of Claims

2. Claims 3 and 15-17 are pending in this application.

Response to Arguments

3. Applicant's arguments, see Page 6, lines 1-5 filed 9/29/2008, with respect to Independent Claim 3 have been fully considered and are persuasive. However, upon further consideration, a new ground(s) of rejection is made in view of Soto et al. (US 2003/0081240).

Regarding Applicant's Argument:

"In contrast the citation to Tateyama et al. is not understood to disclose or suggest a user interface that notifies a user that the printer has a first function of automatically detecting a paper size and a second function of automatically detecting a paper type if a determination unit determines that the printer has the first and second functions, as recited by Claim 3."

Examiner's Response:

Tateyama does not disclose expressly a user interface that notifies a user that the printer has a first function of automatically detecting a paper size and a second function of automatically detecting a paper type if a determination unit determines that the printer has the first and second functions.

Soto discloses a user interface (The print settings software 240 may generate a display (e.g., a graphical user interface (GUI), and the like) including information, such as the selected printing device as disclosed by Soto in [0026]) that notifies a user that the printer has a first function of automatically detecting a paper size and a second function of automatically detecting a paper type (Print settings may include image orientation, predefined media sizes, color settings or options, quality levels, color emulations, and the like.) if a determination unit determines that the printer has the first and second functions (the print settings software 240 displays the print settings for the newly selected printing device (e.g., the printing device 155) (step 335). For example, the print settings software 240 retrieves the print settings for the printing device 155 from the memory 130. The print settings may include the print settings that can be adjusted at the printing device 155, such as print settings adjusted using a control panel on the printing device 155 or adjusted by the printing device 155 using other conventional means as described in [0028]).

Soto & Tateyama are combinable because they are from the same field of endeavor of image processing; e.g., both references disclose methods of determining the capabilities of a printer prior to sending image to the printer.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include a method to determine what the print settings on a printer are configured to. The suggestion/motivation for doing so would be to modify the file which is being sent to the printer after determining what the print settings are. For example, certain embodiments need less memory than conventional printing techniques to facilitate a print setting change. A user may change any print setting that can be controlled by the printer without the need to regenerate the file being transmitted to the printer. Also, certain embodiments reduce the need to have complicated control panels built into printers as disclosed by Soto in [0009]). Therefore, it would have been obvious to combine Soto's adjusting of print settings for a file with Tateyama's digital camera connected to a printer to obtain the invention as specified in order to efficiently utilize system resources such as memory.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tateyama et al. (US 7,062,579) hereafter 'Tateyama' and further in view of Soto et al. (US 2003/0081240).

Regarding Claim 3:

Tateyama et al. discloses a digital camera (e.g., 1101 in Figure 68) which can directly communicate (Column 7, line 65 – Column 8, line 10; e.g., 1394 Serial Bus in Figure 68) with a printer (e.g., 1102 in Figure 68), comprising:

- a receiving unit that receives capability information of the printer from the printer (The device described in Column 3, lines 13-21);

- a determination unit that

- (a) determines (Column 24, lines 51-64), according to the received capability information, whether the printer has a first function of automatically detecting a paper size (Figure 37; 46-2), and

- (b) determines (Column 24, lines 51-64), according to the received capability information, whether the printer has a second function of automatically detecting a paper type (Figure 37; 46-1); and

- a user interface (Display Device 12 in Figure 69) that notifies a user that the printer has the first and second functions if said determination unit determines that the printer has the first and second functions (Column 25, lines 54-56; Figure 41).

Soto discloses a user interface (The print settings software 240 may generate a display (e.g., a graphical user interface (GUI), and the like) including information, such as the selected printing device as disclosed by Soto in [0026]) that notifies a user that the printer has a first function of automatically

detecting a paper size and a second function of automatically detecting a paper type (Print settings may include image orientation, predefined media sizes, color settings or options, quality levels, color emulations, and the like.) if a determination unit determines that the printer has the first and second functions (the print settings software 240 displays the print settings for the newly selected printing device (e.g., the printing device 155) (step 335). For example, the print settings software 240 retrieves the print settings for the printing device 155 from the memory 130. The print settings may include the print settings that can be adjusted at the printing device 155, such as print settings adjusted using a control panel on the printing device 155 or adjusted by the printing device 155 using other conventional means as described in [0028]).

Soto & Tateyama are combinable because they are from the same field of endeavor of image processing; e.g., both references disclose methods of determining the capabilities of a printer prior to sending image to the printer.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include a method to determine what the print settings on a printer are configured to. The suggestion/motivation for doing so would be to modify the file which is being sent to the printer after determining what the print settings are. For example, certain embodiments need less memory than conventional printing techniques to facilitate a print setting change. A user may change any print setting that can be controlled by the printer without the need to regenerate the file being transmitted to the printer. Also, certain embodiments reduce the need to have complicated control panels built into printers as disclosed by Soto in [0009]). Therefore, it would have been obvious to combine Soto's adjusting of print settings for a file with Tateyama's digital camera connected to a printer to obtain the invention as specified in order to efficiently utilize system resources such as memory.

Regarding Claim 15:

Tateyama et al. discloses the digital camera according to claim 3, wherein said user interface (Display Device 12 in Figure 69) inhibits a user from selecting a paper size if said determination unit determines that the printer has the first function (Column 25, lines 54-56; Figure 41).

Regarding Claim 16:

Tateyama et al. discloses the digital camera according to claim 3, wherein said user interface (Display Device 12 in Figure 69) inhibits a user from selecting a paper type if said determination unit determines that the printer has the second function (Column 25, lines 54-56; Figure 41).

Regarding Claim 17:

Tateyama et al. discloses the digital camera according to claim 3, wherein said user interface (Display Device 12 in Figure 69)

(a) inhibits a user from selecting a paper size if said determination unit determines that the printer has the first function (Column 25, lines 54-56; Figure 41)

and

(b) inhibits a user from selecting a paper type if said determination unit determines that the printer has the second function (Column 25, lines 54-56; Figure 41).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ozawa et al. (US 2003/0016378) discloses image processing system which can print an image sensed by the digital camera using the printing apparatus without the intervention of any computer, and a digital camera and printing apparatus suitable for the image processing system.

Examiner Notes

7. The Examiner cites particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully considers the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or as disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. McLean whose telephone number is (571)270-1679. The examiner can normally be reached on Monday through Friday 7:30AM-4:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571.272.7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Neil R. McLean/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625